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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,659	03/17/2004	William Charles Collard	COLLARD ET AL.- 1	2658
25889	7590	07/06/2005	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,659

Applicant(s)

COLLARD ET AL.

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 8, the claim in conjunction with its parent claims appears to limit the container to two conflicting locations (i.e. the spine and coupled to the inside face of the cover), however such structure was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-9, 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, it is not clear how a container is disposed in the spine and coupled to the inside face of the front cover as claimed in claims 6 and 8.

Regarding claim 9, there is no antecedent basis for "said front cover".

Regarding claim 15, the claim requires at least one additional puppet and is dependent from claim 1, however claim 1 already claims a plurality of puppets. Therefore it is not clear if applicant intend to claim at least one additional glove or indeed more puppets on the already claimed glove with another line attached to another puppet. For purposes of examination it is assumed that applicants intend to claim additional gloves.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-10, 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gemma '456 in view of Cabrera '028. Gemma discloses a device for telling stories containing most of the elements of the claims including with respect to claim 1, a book (11), a container coupled to the book (box 1), at least one glove (8) and a plurality of puppets (10) coupled to and formed integral with the glove (col. 3, lines 11-26). The puppet being in the form of a glove containing at least two finger puppets, as required by claim 13, is shown as glove (8) in figure 4 and in finger puppets (10) in

figure 3. Puppets relating to a story from the book, as required by claim 14, are described in col. 3, lines 46-49. An extension in the form of a stage, as required by claim 16, is shown as stage 13 in figure 1. A stage comprising a bottom section, at least one side and a top section, as required by claim 17, is shown in figure 1. A book comprising a front and back cover, as required by claims 19 and 20, is inherent in the book and wherein the stage is coupled to the front and back cover of the book, as also required by claims 19 and 20, is described in col. 3, lines 62-64 (where the stage is considered to be coupled to the front cover through the back cover of the book). A plurality of curtains with at least one curtain coupled to one side section of the stage, as required by claim 18, is shown in figures 1 and 2. A top and bottom section of the stage having folds thereon, as required by claim 21, is shown in figures 1 and 2, where the top stage portion 32 inherently has a fold which allows it to open and close while the bottom portion has a fold between portions 19 and 20 which creates a fold over as shown in figures 1 and 2.

Gemma fails to teach a puppet coupled to the book via a line as required by claim 1 and additional lines and puppets as required by claim 15. However, Cabrera discloses a book and puppet combination where a book (50) is coupled to a puppet (107) through the use of a line (155). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided a string coupling connection between the finger puppet and book of Gemma for the purpose of securing the puppet to the book to prevent loss. With respect to the additional gloves/puppets and additional connecting lines as required by claim 15, it

would have been obvious to incorporate additional puppets connected through a line to the a book (in view of Cabrera) since the number of puppets to be displayed would only depend upon the number of characters in the story and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding the device utilized in connecting the glove to the book, as required by claims 2-5, Cabrera teaches that it is known to couple a book to a puppet using a string, cable or cord (col. 4, lines 47-51). Therefore it would have been obvious to utilize any of the above coupling means to attach the puppet and book of Gemma since all of the above attachment means are known equivalents. Furthermore, the use of any of the above attachment means is considered to be a design choice since applicants do not disclose any critical need or advantage to any particular attachment means (see applicants specification, page 5, paragraph 0016).

Claims 1-2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '521 in view of Baum '209. Solomon discloses a device containing most of the elements of the claims including with reference to claim 1, a book (11), a container coupled to the book (pocket 41) and a plurality of puppets coupled to the book (puppets 21-26) through a line (27). A string, as required by claim 2, is shown as string (27). At least one additional puppet and at least one string, as required by claim 15, are shown as additional puppets (22-26) and strings (27).

Solomon fails to teach that his puppets are coupled to and formed integral with at least one glove as required by claim 1, however Solomon does teach that his puppets can be a variety of puppet types (col. 3, lines 3-6) while Baum teaches that it is known to manufacture puppets coupled and formed integral with gloves (figure 1). Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have manufactured the puppets of Solomon being coupled to and formed integral with at least one glove for the purpose of allowing a user the ability to animate the movements of the puppets.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Solomon '521 and Baum '209, as stated above, and further in view of Akira (JP 2003-071152). Although Solomon, as modified by Baum, discloses most of the elements of the claims, as stated above, the reference fails to teach a container disposed in the spine of the book as required by claim 6, a container being cylindrical as required by claim 7.

Akira discloses a book which teaches that it is known to manufacture a book with a container (3) coupled to the book (2) for storing puppets where the container is disposed in the spine of the book (figure 1) and has a substantially cylindrical shape (described in the abstract).

Regarding claim 8, Solomon teaches a front cover with a front and back face (figure 2, cover having pocket 41) with a container being in the form of a pouch (pocket 41) coupled to a face of the cover (figure 2). Solomon fails to teach the pouch on the inside face of the front cover. However, it would have been obvious to place the

pouch/pocket of Solomon on the inside portion of the front cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Allowable Subject Matter

Claims 11 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed June 10th, 2005 have been fully considered but they are not persuasive. Applicants first argue that Gemma fails to teach the "use of a connecting element in the form of a line or string connecting the puppet or glove to a book" and would not need for a line connecting the puppet to a book because "Gemma is formed from a plurality of different components that are not necessarily connected to the book". In response the examiner points out that Cabrera is relied upon to teach a connection between a puppet and book and further points out that the glove of Gemma is clearly used in very close proximity to the book of Gemma (figure 1) and thus a string connection as taught by Cabrera would have been obvious to prevent loss (as is generally known in the art and taught by Cabrera).

With respect to applicants arguments that the modification as proposed (string connecting the glove of Gemma and the book of Gemma as taught by Cabrera) would

somehow destroy the Gemma reference, it is the position of the examiner that such a proposed modification would in no way destroy the Gemma reference but rather improve upon it since it would prevent the loss of a critical component of the toy.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
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